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OFFICE OF PETITIONS

In re Application of	:
Scott et al.	:
Application No. 10/629,480	: DECISION DISMISSING
Filed: 28 October, 2004	: PETITION
Attorney Docket No. SILA:057C1	:

This is a decision on the petition filed on 28 October, 2004, requesting that the above-identified application be accorded a filing date of 29 July, 2003, with 37 pages of specification, including 35 claims, and 18 sheets of drawings as a part of the original disclosure.

The petition is dismissed.

The application was deposited 29 July, 2003. The original application papers consisted of a transmittal letter, preliminary amendment, and an Information Disclosure Statement. However, on 21 September, 2004, Initial Patent Examination Division mailed a "Notice Of Incomplete Nonprovisional Application" stating that the application had not been accorded a filing date because the specification and an oath or declaration were missing.

In response, on 28 October, 2004, the present petition was filed, accompanied by, *inter alia*, 37 pages of specification and claims and 18 sheets of drawings.

Petitioners assert that the present application is a continuation of Application No. 09/470,273, and that the failure to include a copy of the prior application was an inadvertent mistake. Petitioners further assert that the transmittal letter and preliminary amendment evidence petitioners' intent to file a copy of the prior application with the application papers deposited on 29 July, 2003.

Petitioners' argument has been considered, but is not persuasive. Whether the specification and drawings which petitioners intended to file with this application were a part of a copending application is not an issue here since the copending application was not specifically incorporated by reference into the disclosure of this application.¹ The mere reference to another application is not an incorporation of anything therein into the application containing the reference.² To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. The specification and drawings which petitioners seek entry of were simply not filed in the USPTO on 29 July, 2003.

To this end, it is noted that the preliminary amendment filed with the original application papers expressly incorporates several other applications, but not the prior co-pending application. Instead, reference is merely made to the prior co-pending application without incorporating the prior co-pending application by reference.

In summary, while this is an unfortunate situation, the USPTO is precluded from offering the requested relief. The showing of record is that although petitioners intended to file a specification with the application papers deposited on 29 July, 2003, the earliest date a specification was actually received in the USPTO was 28 October, 2004. As such, the application is entitled to a filing date of 28 October, 2004.

As this petition was not necessitated by an error on the part of the USPTO, the petition fee will not be refunded.

The application will be processed and examined with a filing date of 28 October, 2004, using the application papers filed on that date.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of 28 October, 2004, using the original application papers as well as the specification, claims, and drawings filed on that date.

¹See MPEP 608.01(p).

²See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).

Telephone inquiries specific to this matter should be directed to the undersigned at 571 272-3231.

A handwritten signature in black ink, appearing to read "D Wood", is positioned above the printed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions